

COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)

Docket No.
PAT-1556

In Re Application Of: Zheng

JAN 22 2009

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/806,918	3/22/2004	Hawk		3637	2471

Invention: Collapsible covers and shade

COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☒ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

from: December 23, 2008

Date

until: January 23, 2008

Date

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Fee for Appeal Brief: \$270.00

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☐ Please charge Deposit Account No. in the amount of

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☐ Any patent application processing fees under 37 CFR 1.17.

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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
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10/806,918	3/22/2004	Hawk		3637	2471

Invention: **Collapsible covers and shade**

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:



Raymond Sun

Signature

Dated: **1-20-09**

Raymond Sun
Reg. No. 35,699

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CC:



PAT-1556

NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)	
)	Art Unit: 3637
YU ZHENG)	
)	Examiner: Noah C. Hawk
Serial No.: 10/806,918)	
)	
Filing Date: March 22, 2004)	
)	
For: COLLAPSIBLE COVERS AND SHADES)	
<hr/>		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 CFR §41.37

Dear Sir:

This is an appeal from the rejection of claims 38-40 under 35 U.S.C §103(a) as being unpatentable over USP 6,446,396 to Marangoni et al. ("Marangoni") in view of Pub. No. 2001/0039959 to Zheng ("Zheng '959") and USP 6,360,761 to Zheng ("Zheng '761"). For the reasons discussed below, Applicant requests reversal of the rejection, and allowance of the claims. The Notice of Appeal was dated October 23, 2008, making this Appeal Brief due on December 23, 2008. Applicant is filing herewith a Petition for One-Month Extension of Time to extend the deadline to January 23, 2009.

01/23/2009 NNGUYEN1 00000021 10006918

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REAL PARTY IN INTEREST

The real party in interest is Patent Category Corp., the assignee of record.

RELATED APPEALS AND INTERFERENCES

None

JURISDICTIONAL STATEMENT

This is an appeal under 37 CFR §41.37 from the Office Action dated June 20, 2008 in which claims 38-40 were rejected under 35 U.S.C §103(a) as being unpatentable over USP 6,446,396 to Marangoni et al. ("Marangoni") in view of Pub. No. 2001/0039959 to Zheng ("Zheng '959") and USP 6,360,761 to Zheng ("Zheng '761").

The Notice of Appeal was dated October 23, 2008, making this Appeal Brief due on December 23, 2008. Applicant is filing herewith a Petition for One-Month Extension of Time to extend the deadline to January 23, 2009.

STATUS OF THE CLAIMS

Canceled Claims:

Claims 1-37 have been canceled.

Withdrawn Claims:

Claim 41 has been withdrawn.

Pending Claims:

Claims 38-40 are pending and set forth in attached Appendix A.

Claim 38-40 are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments to any of the claims have been filed subsequent to the final rejection.

GROUND OF REJECTION

Claims 38-40 are rejected under 35 U.S.C §103(a) as being unpatentable over USP 6,446,396 to Marangoni et al. ("Marangoni") in view of Pub. No. 2001/0039959 to Zheng ("Zheng '959") and USP 6,360,761 to Zheng ("Zheng '761"). Zheng '959 is actually USP 6,766,815.

STATEMENT OF THE FACTS

The material facts relevant to the rejections on appeal are as follows:

The rejection is based on a combination of Marangoni, Zheng '959 and Zheng '761.

Marangoni discloses an office structure constructed using a wall system for partitioning interior space within a building, the wall system comprising rectangular fascia panels 24 that are secured to a wall frame. See col. 3, line 58 to col. 4, line 19, and FIG. 1 of Marangoni. These panels 24 are not readily removable, and are used to define actual rooms or offices.

Zheng '959 is actually USP 6,766,815, and discloses a four-sided structure in FIG. 4 where the four sides are defined by panels that can be twisted and folded. See FIGS. 5A-5E of Zheng '959. All four sides of the structure in FIG. 4 are stitched to each other as shown in FIG. 3, so these panels cannot be separated without destroying the stitched connections. See col. 4, lines 13-30 of USP 6,766,815.

Zheng '761 discloses different structures that are made up of panels that can be twisted and folded. FIG. 11 shows one structure 20 with four panels, and two individual panels 142 and 144.

ARGUMENTS

I. Claims 38-40 stand rejected under 35 U.S.C §103(a) as being unpatentable over Marangoni in view of Zheng '959 and Zheng '761

A. THE EXAMINER'S REJECTION

The examiner's rejection of claims 38-40 is set forth on pages 2-4 of the Office Action dated June 20, 2008 and will not be repeated here. In summary, the examiner asserts that Marangoni teaches furniture positioned within a space defined by a ring of panels, but acknowledges that Marangoni does not teach "the details of the panels". To fill this gap, the examiner relies on FIG. 4 of Zheng '959 as disclosing a ring of panels, yet acknowledges that the combination of Marangoni and Zheng '959 still fails to disclose "that the panels are different sizes or that they are removably connected together". To this end, the examiner relies on FIG. 11 of Zheng '761 to show panels of different shapes and sizes, and that "the panels are removably connected (via 158) to each other".

B. EVEN IF THE PROPOSED MODIFICATIONS WERE PROPER, THE MODIFICATIONS WOULD STILL NOT YIELD ALL THE LIMITATIONS OF THE CLAIMED INVENTION

Independent claim 38 recites, among other limitations and elements, two separate and independent structures, each having two panels, with the two panels in each structure having different shapes in a manner such that one of the panels in each structure being less than half the size of the other panel. See FIG. 7.

In contrast, even if the combination proposed by the Examiner is proper, such a combination would still not yield all the limitations of claim 38. For example, none of the cited references disclose or suggest two separate and independent structures, each having two panels, with the two panels in each structure having different shapes in a manner such that one of the panels in each structure being less than half the size of the other panel. First, the Examiner acknowledges that Marangoni does not teach these limitations. Second, all four panels in FIG. 4 of Zheng '959 are stitched to each other, so that they are not separable. Also, FIG. 4 of Zheng '959 does not teach or suggest two separate structures, each having two panels. Third, FIG. 11 of Zheng '761 does not teach or suggest two separate structures, each having two panels. FIG. 11 shows

one structure 20 with four panels, and two individual panels 142 and 144. Also, FIG. 11 of Zheng '761 does not teach or suggest that any panel is less than half the size of any other panel.

These limitations are significant because the disparity between the sizes of the two smaller panels within a structure make it impossible for such a four-sided connected structure to be twisted and folded. For example, referring to FIG. 7 of the present invention, if the four panels were hingedly connected along all of the sides of the panels, it would not be possible to fold the four panels on top of each other to form a stack of panels that can be twisted and folded. Therefore, the claimed invention provides two separate structures having panels of different shapes and sizes so that the panels of each separate structure can be stacked and then easily twisted and folded.

Thus, even if Zheng '761 and Zheng '959 were combined with Marangoni, the resulting combination would still not yield the claimed invention.

C. THE PROPOSED MODIFICATIONS/COMBINATION ARE IMPROPER BECAUSE THEY ARE THE RESULT OF IMPROPER HINDSIGHT RECONSTRUCTION

Applicant respectfully submits that the proposed modifications/combination suggested by the examiner are improper because they are the result of improper hindsight reconstruction. There are at least the following reasons why the proposed modifications/combination are improper:

(i) The rejection would require that the large solid wall panels of Marangoni be replaced with the collapsible fabric panels described in the Zheng prior art references. The wall panels in Marangoni are used to divide office space to form separate rooms or compartments. However, the Zheng collapsible panels do not have the structural stability to function as walls or dividers for rooms. In the claimed invention, the collapsible panels are used to surround furniture for decoration, and not for use as wall panels. Therefore, there is no motivation or incentive for a person skilled in the art to look to the teachings in Marangoni.

(ii) Assuming that the examiner is correct in that Marangoni can be modified to replace the wall panels in Marangoni with the collapsible panels in Zheng '959 (which Applicant disputes), why would a person skilled in the art have any reason or incentive to have the collapsible panels in Zheng '959 be removable from each other?

(iii) The specific arrangement, connections and details of the claimed panels are not even shown, described or suggested in either of the Zheng '959 or Zheng '761 references. In other words, there is no disclosure as to which sides are to be stitched, which sides are to be removable, which panels are to be larger or smaller, etc., so even if the three references can be combined (which Applicant disputes), there are still many missing limitations still need to be added to reach the claimed invention. Applicant submits that the addition of these limitations can only be derived through impermissible hindsight reconstruction.

In other words, the rejection requires that a person skilled in the art start with FIG. 1 of Marangoni, and then make numerous significant modifications, none of which are taught or suggested by any of the prior art. Each of these three modifications is based on reconstructing the claimed invention from its own claimed elements, which is not permitted under the law. Even if any one of the three modifications can be supported by any teaching, incentive or suggestion from the prior art or common knowledge, Applicant respectfully submits that it would NOT be obvious to a person skilled in the art to have any incentive to incorporate all the modifications in the specific arrangements recited in claim 38.

In summary, the proposed modifications required to support the rejection have many "missing gaps". Many assumptions are made where there is no basis for any of these assumptions. This is a clear sign of the fact that impermissible hindsight reconstruction is being used.

In light of the above, claim 38, and claims 39 and 40 depending therefrom, are submitted to be in condition for allowance.

D. APPLICANT'S RESPONSES TO THE EXAMINER'S RESPONSES

Applicant responds to the examiner's comments on page 3 (lines 7-12) and page 5 (lines 1-7) of the Office Action dated June 20, 2008 as follows:

On page 3, lines 7-12, the examiner asserts that it would be obvious to modify the combination of Marangoni and Zheng '761:

"... to use removable connections between the first and fourth and between the second and third panels

Such a combination would have two separate and independent structures formed by the 1st and 2nd and 3rd and 4th panels respectively."

On page 5, lines 1-5, the examiner asserts that it would be obvious to:

"replace any of the connections between panels with a removable connection as taught by Zheng '761 ... Such a modified device would inherently have two independent and separate structures."

In response to these comments, Applicant submits that this proposed modification is based on reconstructing the claimed invention from its own claimed elements. What is the incentive or reason for providing the removable connection "between the first and fourth and between the second and third panels"? Why not provide the removable connection between other panels (e.g., between the first and third)? Why provide two removable connections instead of providing removable connections between all the panels (as FIG. 11 of Zheng '761 would more likely suggest), or providing only one removable connection? Even if it is true that it would be obvious to "replace any of the connections between panels with a removable connection", these comment does not explain or address the questions raised above.

In summary, the rejection appears to be broadly asserting that the combination of Zheng '959 and Zheng '761 renders obvious almost any arrangement of collapsible panels to form a structure. All variations of sizes, shapes, orientations and connections would be obvious. Applicant submits that Section 103 cannot be so broad, and some weight must be given to specific arrangements, sizes and connections of panels, where as here, the claimed invention provides a specific arrangement of two separate structures having panels of different shapes and sizes so that a specific function or purpose can be accomplished (i.e., the panels of each separate structure can be stacked and then easily twisted and folded).

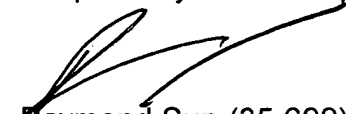
E. THE DEPENDENT CLAIMS

Claims 39 and 40 depend from claim 38 and are submitted to be allowable for the same reasons.

SUMMARY

For the reasons explained above, Applicant respectfully submits that pending claims 38-40 clearly distinguish over the cited references. It is clear from the above detailed explanations that the rejection is based on impermissible hindsight reconstruction. As a result, Applicant respectfully requests that the examiner's rejection be reversed.

Respectfully submitted,



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Dated: January 21, 2009

CERTIFICATE OF MAILING

I hereby certify that this paper and its enclosures are being deposited with the United States Postal service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Date: January 21, 2009

By:



Raymond Sun

APPENDIX A (CLAIMS)

Claims Section

38. (Rejected) In combination:

an item of furniture;

a first structure having a first panel and a second panel; and

a second structure having a third panel and a fourth panel, the second structure being independent and separate from the first structure;

wherein:

(i) each panel is defined by a foldable frame member that has a folded and an unfolded orientation, and a sheet material covering the respective frame member when the respective frame member is in the unfolded orientation, each panel further having a left side and a right side;

(ii) the right side of the first panel is hingedly connected to the left side of the second panel, the right side of the third panel is hingedly connected to the left side of the fourth panel, the left side of the first panel is removably connected to the right side of the fourth panel, and the right side of the second panel is removably connected to the left side of the third panel, with the four panels connected together and oriented vertically to form a ring of panels that define a space therebetween;

(iii) the first and second panels have different shapes with the second panel being less than half the size of the first panel, and the third and fourth panels have different shapes with the fourth panel being less than half the size of the third panel;

(iv) each frame member forms a plurality of concentric frame members when it has been twisted and folded into the folded orientation; and

(v) the item of furniture is positioned in the space and surrounded by the ring of panels.

39. (Rejected) The combination of claim 38, wherein each panel has a periphery, and further including a peripheral sleeve extending along the periphery of each panel for retaining the respective frame member.

40. (Rejected) The combination of claim 38, wherein the first and third panels have a first shape, and the second and fourth panels have a second shape that is different from the first shape.

41. (Withdrawn) A method of decorating an item of furniture, comprising:

(a) providing a first structure having a first panel and a second panel, and a second structure having a third panel and a fourth panel, the second structure being independent and separate from the first structure, wherein:

(i) each panel is defined by a foldable frame member that has a folded and an unfolded orientation, and a sheet material covering the respective frame member when the respective frame member is in the unfolded orientation, each panel further having a left side and a right side,

(ii) the right side of the first panel is hingedly connected to the left side of the second panel, and the right side of the third panel is hingedly connected to the left side of the fourth panel, and

(iii) the first and second panels have different shapes with the second panel being less than half the size of the first panel, and the third and fourth panels have different shapes with the fourth panel being less than half the size of the third panel;

(b) positioning the first, second, third and fourth panels around the item of furniture by removably connecting the left side of the first panel to the right side of the fourth panel, and removably connecting the right side of the second panel to the left side of the third panel, such that the four panels are oriented vertically to form a ring of panels that surround the item of furniture;

(c) separating the first and second structures by removing the removable connections;

(d) folding the first panel on to the second panel to form a first stack of panels;

(e) folding the the third panel on to the fourth panel to form a second stack of panels; and

(f) twisting and folding each stack of panels such that each separate frame member forms a plurality of concentric frame members when it has been twisted and folded into the folded orientation.

Claim Support Section

38. In combination:

an item of furniture **{pg. 6, line 27}**;

a first structure having a first panel and a second panel **{page 5, lines 13-15; page 6, lines 20-22}**; and

a second structure having a third panel and a fourth panel **{page 5, lines 13-15; page 6, lines 20-22}**, the second structure being independent and separate from the first structure **{page 6, line 20}**;

wherein:

(i) each panel is defined by a foldable frame member that has a folded and an unfolded orientation **{page 3, lines 1-14}**, and a sheet material covering the respective frame member when the respective frame member is in the unfolded orientation **{page 3, lines 18-20}**, each panel further having a left side and a right side **{page 2, line 32}**;

(ii) the right side of the first panel is hingedly connected to the left side of the second panel **{page 5, line 15}**, the right side of the third panel is hingedly connected to the left side of the fourth panel **{page 5, line 15}**, the left side of the first panel is removably connected to the right side of the fourth panel **{page 6, lines 23-25}**, and the right side of the second panel is removably connected to the left side of the third panel **{page 6, lines 23-25}**, with the four panels connected together and oriented vertically to form a ring of panels that define a space therebetween **{page 6, lines 25-27}**;

(iii) the first and second panels have different shapes with the second panel being less than half the size of the first panel **{page 6, lines 3-9}**, and the third and fourth panels have different shapes with the fourth panel being less than half the size of the third panel **{page 6, lines 3-9}**;

(iv) each frame member forms a plurality of concentric frame members when it has been twisted and folded into the folded orientation **{page 3, line 30 to page 4, line 4}**; and

(v) the item of furniture is positioned in the space and surrounded by the ring of panels **{page 6, lines 25-27}**.

39. (Rejected) The combination of claim 38, wherein each panel has a periphery, and further including a peripheral sleeve extending along the periphery of each panel for retaining the respective frame member **{page 3, lines 1-5}**.

40. (Rejected) The combination of claim 38, wherein the first and third panels have a first shape, and the second and fourth panels have a second shape that is different from the first shape **{page 6, lines 20-22}**.

Drawing Analysis Section

38. In combination:

an item of furniture **{FIG. 7}**;

a first structure having a first panel and a second panel **{FIG. 7}**; and

a second structure having a third panel and a fourth panel **{FIG. 7}**, the second structure being independent and separate from the first structure **{FIG. 7}**;

wherein:

(i) each panel is defined by a foldable frame member that has a folded and an unfolded orientation **{FIGS. 1-3E}**, and a sheet material covering the respective frame member when the respective frame member is in the unfolded orientation **{FIG. 1}**, each panel further having a left side and a right side **{FIG. 7}**;

(ii) the right side of the first panel is hingedly connected to the left side of the second panel **{FIG. 7}**, the right side of the third panel is hingedly connected to the left side of the fourth panel **{FIG. 7}**, the left side of the first panel is removably connected to the right side of the fourth panel **{FIG. 7}**, and the right side of the second panel is removably connected to the left side of the third panel **{FIG. 7}**, with the four panels connected together and oriented vertically to form a ring of panels that define a space therebetween **{FIG. 7}**;

(iii) the first and second panels have different shapes with the second panel being less than half the size of the first panel **{FIG. 7}**, and the third and fourth panels have different shapes with the fourth panel being less than half the size of the third panel **{FIG. 7}**;

(iv) each frame member forms a plurality of concentric frame members when it has been twisted and folded into the folded orientation **{FIG. 3E}**; and

(v) the item of furniture is positioned in the space and surrounded by the ring of panels **{FIG. 7}**.

39. (Rejected) The combination of claim 38, wherein each panel has a periphery, and further including a peripheral sleeve extending along the periphery of each panel for retaining the respective frame member **{FIGS. 1-2}**.

40. (Rejected) The combination of claim 38, wherein the first and third panels have a first shape, and the second and fourth panels have a second shape that is different from the first shape **{FIG. 7}**.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None